

--13. (Five-Times Amended) A method of informing a user of a received call from a remote caller to a communication apparatus, comprising the steps of:

waiting to receive a call;

[ringing] generating an alert sound upon receiving said

call; and

changing a volume of the generated alert sound only for said call when the alert sound is being generated and a predetermined operation is specified by the user, without affecting the volume of the alert sound for subsequent future received calls, while leaving a call ringing status, as perceived by the remote caller, of the call from the remote caller to the communication apparatus unchanged.--

#### REMARKS

Claims 1-19 remain in the application with claims 1 and 13 having been amended hereby.

Reconsideration is respectfully requested of the rejection of claims 1-5, 11-15, 18 and 19 under 35 U.S.C. 103(a), as being unpatentable over U.S. Patent No. 5,657,372 to Ahlberg et al. ("Ahlberg '372") in view of U.S. Patent No. 5,493,285 to Yoshizawa ("Yoshizawa '285").

The Examiner asserted that the invention recited in the

claims is substantially disclosed by Ahlberg '372. Ahlberg '372, however, as the Examiner admitted, does not disclose or suggest that (1) means for specifying a predetermined operation is operated by a user, and (2) the control means controls the alert sound generator to change a volume of the generated alert sound only for the received call, without affecting the volume of the alert sound for future receiver calls, while a call ringing state, as perceived by the remote caller, of the terminal from the remote caller remains unchanged, as provided in claim 1.

The Examiner alleged that Yoshizawa '285 discloses that, in response to user operation of a switch 19, a controller 14 controls an alert sound generator to change a volume of the alert sound only for the received call, without affecting the volume of the alert sound for future received calls, while a call ringing state, as perceived by the remote caller, of the terminal remains unchanged. The Examiner also alleged that it would have been obvious to one of ordinary skill in the art at the time of the invention to combine the teachings of Ahlberg '372 and Yoshizawa '285 to modify the telephone of Ahlberg '372 to include means for specifying the predetermined operation by a user, wherein the control means controls the alert sound generator to change a volume of the alert sound only for the received call, without affecting the volume of the alert sound for future

received calls, while a call ringing state, as perceived by the remote caller, of the terminal from the remote caller remains unchanged in order to change calling formats by the user according to the user's situation or environment.

It is respectfully submitted that even a combination of the teachings of Ahlberg '372 and Yoshizawa '285 fails to disclose or suggest the invention recited in the claims.

Ahlberg et al. relates to a cellular telephone system which permits a user of a cellular telephone to accept a telephone call from another telephone while delaying the establishment of voice communications with the other telephone, by the user's operation of a hold selection means. In response to the user's operation of the hold selection means, a communication link is established with the other (i.e., calling) telephone, and a message indicating that the call is accepted is transmitted to the caller.

While Ahlberg '372 describes a cellular telephone in which the user's operation of a call hold selection means in response to an alert sound designating a received call triggers the cellular telephone to establish a communication link with the caller's telephone and announce to the caller that the call is accepted, Ahlberg '372, as the Examiner admitted, fails to disclose or suggest that (1) when the alert sound generator is

generating the alert sound and the means for specifying the predetermined operation is operated by the user, the control means controls the alert sound generator to change a volume of the generated alert sound only for the received call, without affecting the volume of the alert sound for future received calls, while leaving a call ringing state, as perceived by the remote caller, of the call to the terminal from the remote caller unchanged, as set forth in five times amended claim 1, and (2) changing a volume of the generated alert sound only for the call when the alert sound is being generated and a predetermined operation is specified by the user, without affecting the volume of the alert sound for subsequent future received calls, while leaving a call ringing status, as perceived by the remote caller, of the call from the remote caller to the communication apparatus unchanged, as set forth in five times amended claim 13.

Yoshizawa '285 does not cure the deficiencies of Ahlberg '372.

Yoshizawa '285 relates to a paging receiver having means for determining that a received message is "urgent", including a timer for maintaining the current time. When the receiver receives a message signal, the received message signal is stamped with the current time from the timer, and thereafter compared with previously received messages stored in memory with

their associated stamped time information. If the currently received message is coincident with a stored message and a difference between the stamped time of the two is within a predetermined amount, then the message is deemed urgent, and a louder than normal alert sound is generated by the pager.

While Yoshizawa '285 describes that the pager apparatus, in response to operation of a switch by a user, would terminate a call alert sound announced to the user through a speaker, the party who sent the page message, in the context of Yoshizawa '285, unlike the present invention, does not perceive a call ringing state since the calling party simply places the paging call without waiting for connection with the pager apparatus. Therefore, Yoshizawa '285, like Ahlberg '372, does not disclose or suggest (1) that when the alert sound generator is generating the alert sound and the means for specifying the predetermined operation is operated by the user, the control means controls the alert sound generator to change a volume of the generated alert sound only for the received call, without affecting the volume of the alert sound for future received calls, while leaving a call ringing state, as perceived by the remote caller, of the call to the terminal from the remote caller unchanged, as set forth in five times amended claim 1, and (2) changing a volume of the generated alert sound only for the call

when the alert sound is being generated and a predetermined operation is specified by the user, without affecting the volume of the alert sound for subsequent future received calls, while leaving a call ringing status, as perceived by the remote caller, of the call from the remote caller to the communication apparatus unchanged, as set forth in five times amended claim 13.

Therefore, even if it would have been obvious for one of ordinary skill in the art at the time of the invention to combine the teachings of Ahlberg '372 and Yoshizawa '285, as suggested by the Examiner, the combination would nevertheless fail to disclose the claimed invention because neither Ahlberg '372 nor Yoshizawa '285 discloses or suggests (1) that when the alert sound generator is generating the alert sound and the means for specifying the predetermined operation is operated by the user, the control means controls the alert sound generator to change a volume of the generated alert sound only for the received call, without affecting the volume of the alert sound for future received calls, while leaving a call ringing state, as perceived by the remote caller, of the call to the terminal from the remote caller unchanged, as set forth in five times amended claim 1, and (2) changing a volume of the generated alert sound only for the call when the alert sound is being generated and a predetermined operation is specified by the user, without

affecting the volume of the alert sound for subsequent future received calls, while leaving a call ringing status, as perceived by the remote caller, of the call from the remote caller to the communication apparatus unchanged, as set forth in five times amended claim 13.

Claims 2-5, 11 and 12 depend either directly or indirectly from claim 1 which for the reasons set forth hereinabove is thought to be patentably distinct over the cited prior art and for at least those very same reasons, claims 2-5, 11 and 12 are also submitted to be patentably distinct thereover.

Claims 14, 15, 18 and 19 depend either directly or indirectly from claim 13 which for the reasons set forth hereinabove is thought to be patentably distinct over the cited prior art and for at least those very same reasons, claims 14, 15, 18 and 19 are also submitted to be patentably distinct thereover.

Further, in regard to claims 4, 5 and 15, the Examiner stated that Ahlberg '372 and Yoshizawa '285 fail to disclose a power key. The Examiner stated that power keys, such as a on/off switch in a telephone keypad, are well known in the art. The Examiner alleged that it would have been obvious to one of ordinary skill in the art at the time of the invention to provide a power key for turning a telephone on or off. In regard to

claim 14, the Examiner stated that Ahlberg '372 and Yoshizawa '285 fail to disclose depressing a predetermined key for a time shorter than a predetermined period of time. The Examiner alleged that since Ahlberg '372 discloses activating a hold selection means, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to provide a predetermined key that may be depressed for a time shorter than a predetermined period of time in order to place the caller on hold.

Applicants do not contend that recitation of a power key, by itself, in the claims is a novel feature. It is believed, however, that the cited art does not disclose or suggest using a power key both to turn on and off the supply of power and to change a volume of the generated alert sound.

Should the Examiner disagree therewith, it is respectfully requested that the Examiner specify where in the cited document there is a basis for such disagreement.

Reconsideration is respectfully requested of the rejection of claim 16 under 35 U.S.C. 103(a), as being unpatentable over Ahlberg '372 in view of Yoshizawa '285 and further in view of U.S. Patent No. 5,276,729 to Higuchi et al. ("Higuchi '729").

The Examiner admitted that Ahlberg '372 and Yoshizawa



'285 fail to disclose that the predetermined key is depressed for a duration of time less than a predetermined period of time substantially equal to one second. The Examiner stated that Higuchi '729 discloses that a user may answer a call by pressing a send key. The Examiner alleged that it would have been obvious to one of ordinary skill in the art at the time of the invention to combine the teachings of Ahlberg '372, Yoshizawa '285 and Higuchi '729 to modify the combination of Ahlberg '372 and Yoshizawa '285 to provide a predetermined period of time substantially equal to one second for answering an incoming call to discontinue a telephones ringing.

As pointed out above, the combination of the teachings of Ahlberg '372 and Yoshizawa '285 fails to disclose or suggest changing a volume of the generated alert sound only for the call when the alert sound is being generated and a predetermined operation is specified by the user, without affecting the volume of the alert sound for subsequent future received calls, while leaving a call ringing status, as perceived by the remote caller, of the call from the remote caller to the communication apparatus unchanged, as set forth in claim 13 from which claim 16 depends indirectly.

Higuchi '729 does not cure the deficiencies of Ahlberg '372 and Yoshizawa '285.

Higuchi '729 relates to a remotely programmable radiotelephone which is controllable using dual-tone, multiple-frequency tones.

While Higuchi '729 describes that the radiotelephone has a conventional keypad buttons, including a send key, Higuchi '729, like Ahlberg '372 and Yoshizawa '285 fails to disclose or suggest changing a volume of the generated alert sound only for the call when the alert sound is being generated and a predetermined operation is specified by the user, without affecting the volume of the alert sound for subsequent future received calls, while leaving a call ringing status, as perceived by the remote caller, of the call from the remote caller to the communication apparatus unchanged, as set forth in five times amended claim 13 from which claim 16 depends indirectly.

Therefore, even if it would have been obvious for one of ordinary skill in the art at the time of the invention to modify the combination of Ahlberg '372 and Yoshizawa '285 according to the teachings of Higuchi '729, as suggested by the Examiner, the modified combination would nevertheless fail to disclose the claimed invention because neither Ahlberg '372 nor Yoshizawa '285 nor Higuchi '729 discloses or suggests changing a volume of the generated alert sound only for the call when the alert sound is being generated and a predetermined operation is

specified by the user, without affecting the volume of the alert sound for subsequent future received calls, while leaving a call ringing status, as perceived by the remote caller, of the call from the remote caller to the communication apparatus unchanged, as set forth in five times amended claim 13 from which claim 16 depends indirectly.

Reconsideration is respectfully requested of the rejection of claims 6-10 and 17 under 35 U.S.C. 103(a) as being unpatentable over Ahlberg '372 in view of Yoshizawa '285 and further in view of U.S. Patent No. 5,491,745 to Roeder ("Roeder '745") and U.S. Patent No. 5,406,618 to Knuth et al. ("Knuth '618").

The Examiner asserted that the invention recited in the claims is substantially disclosed by Ahlberg '372 and Yoshizawa '285. Ahlberg '372 and Yoshizawa '285, however, as the Examiner admitted, do not disclose a power source, wherein the control means breaks off power when the power key is depressed for at least a predetermined period of time and the control means changes the state of the alert generator when the power key is depressed shorter than the predetermined period of time.

The Examiner alleged that telephones comprising a control means, multifunction keys and a power source is purportedly well known in the art, such as a power key used to

power on/off a telephone by pressing a key, as a result of which a ringing signal of an incoming call is eliminated. The Examiner stated that Roeder '745 discloses a dual mode keypad permitting one touch dialing. The Examiner stated that Knuth '618 teaches a one touch control telephone answering device that can perform multiple functions all by activating a signal button. The Examiner alleged that it would have been obvious to one of ordinary skill in the art at the time of the invention was made to provide the combination of Ahlberg '372 and Yoshizawa '285 with a power source, wherein the control means breaks off power when the power key is depressed for at least a predetermined period of time and the control means changes the state of the alert generator when the power key is depressed for a time period shorter than the predetermined period of time in order to provide one touch activation such as turning off a telephone ringing signal by pressing a signal key without eliminating the regular function of a standard keypad, as purportedly suggested by Roeder '745 and Knuth '618.

Regarding claim 17, the combination of Ahlberg '372 and Yoshizawa '285, as the Examiner admitted, fails to disclose that the step of changing the state of the alert sound includes toggling the predetermined operation. The Examiner alleged that the teaching of toggling a telephone key in a telephone is well

known in the art such as a dual mode keypad permitting one touch dialing, as taught by Roeder '745, and a one touch control telephone answering device that can perform multiple functions all by activating a signal button, as taught by Knuth '618. The Examiner alleged that it would have been obvious to one of ordinary skill in the art at the time of the invention was made to provide multifunction operation of a single key as purportedly taught by Roeder '745 and Knuth '618.

As pointed out above, Ahlberg '372 and Yoshizawa '285 fail to disclose or suggest (1) that when the alert sound generator is generating the alert sound and the means for specifying the predetermined operation is operated by the user, the control means controls the alert sound generator to change a volume of the generated alert sound only for the received call, without affecting the volume of the alert sound for future received calls, while leaving a call ringing state, as perceived by the remote caller, of the call to the terminal from the remote caller unchanged, as set forth in five times amended claim 1 from which claims 6-10 depend indirectly, and (2) changing a volume of the generated alert sound only for the call when the alert sound is being generated and a predetermined operation is specified by the user, without affecting the volume of the alert sound for subsequent future received calls, while leaving a call

ringing status, as perceived by the remote caller, of the call from the remote caller to the communication apparatus unchanged, as set forth in five times amended claim 13 from which claim 17 depends directly.

Roeder '745 and Knuth '618 do not cure the deficiencies of Ahlberg '372 and Yoshizawa '285.

Roeder '745 relates to a telephone apparatus which retrieves and dials previously stored telephone or billing account numbers by pressing one of the keys of a standard 12-key keypad.

Knuth '618 relates to a telephone answering device that is activated by a proximity sensor when a user crosses its field of detection and whose operation is controlled by simple voice commands.

While Roeder '745 describes a dual mode keypad permitting one touch dialing and Knuth '618 describes conventional telephone answering devices in which functions can be activated by depressing a single key, Roeder '745 and Knuth '618, like Ahlberg '372 and Yoshizawa '285, fail to disclose or suggest (1) that when the alert sound generator is generating the alert sound and the means for specifying the predetermined operation is operated by the user, the control means controls the alert sound generator to change a volume of the generated alert

sound only for the received call, without affecting the volume of the alert sound for future received calls, while leaving a call ringing state, as perceived by the remote caller, of the call to the terminal from the remote caller unchanged, as set forth in five times amended claim 1 from which claims 6-10 depend indirectly, and (2) changing a volume of the generated alert sound only for the call when the alert sound is being generated and a predetermined operation is specified by the user, without affecting the volume of the alert sound for subsequent future received calls, while leaving a call ringing status, as perceived by the remote caller, of the call from the remote caller to the communication apparatus unchanged, as set forth in five times amended claim 13 from which claim 17 depends directly.

Therefore, even if it would have been obvious for one of ordinary skill in the art at the time of the invention to combine the teachings of Ahlberg '372, Yoshizawa '285, Roeder '745 and Knuth '618 in the manner suggested by the Examiner, the combination would nevertheless fail to disclose the claimed invention because neither Ahlberg '372 nor Yoshizawa '285 nor Roeder '745 nor Knuth '618 discloses or suggests (1) that when the alert sound generator is generating the alert sound and the means for specifying the predetermined operation is operated by the user, the control means controls the alert sound generator

to change a volume of the generated alert sound only for the received call, without affecting the volume of the alert sound for future received calls, while leaving a call ringing state, as perceived by the remote caller, of the call to the terminal from the remote caller unchanged, as set forth in five times amended claim 1 from which claims 6-10 depend indirectly, and (2) changing a volume of the generated alert sound only for the call when the alert sound is being generated and a predetermined operation is specified by the user, without affecting the volume of the alert sound for subsequent future received calls, while leaving a call ringing status, as perceived by the remote caller, of the call from the remote caller to the communication apparatus unchanged, as set forth in five times amended claim 13 from which claim 17 depends directly.

Accordingly, it is respectfully submitted that there is no showing or suggestion in the prior art of record of a communication terminal for informing a user of a received call from a remote caller by an alert sound, wherein when the alert sound generator is generating the alert sound and the means for specifying the predetermined operation is operated by the user, the control means controls the alert sound generator to change a volume of the generated alert sound only for the received call,



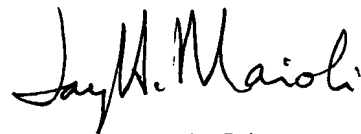
without affecting the volume of the alert sound for future received calls, while leaving a call ringing state, as perceived by the remote caller, of the call to the terminal from the remote caller unchanged, in any of the proper references for consideration alone or in combination absent the teaching of the present invention as set forth in the claims.

Claims 1 and 13 have been amended hereby to more clearly recite the features of the present invention. Therefore, it is respectfully submitted that the amendments made to the claims hereby raise no new issues requiring further consideration and/or search and, thus, the amendments should be entered.

Favorable reconsideration is earnestly solicited.

Respectfully submitted,

COOPER & DUNHAM LLP

A handwritten signature in black ink, appearing to read "Jay H. Maioli". The signature is written in a cursive, flowing style.

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JHM/PT